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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/605,246	06/28/2000	David L. Patton	81219F-P	5703
1333	7590	07/13/2004	EXAMINER	
PATENT LEGAL STAFF EASTMAN KODAK COMPANY 343 STATE STREET ROCHESTER, NY 14650-2201			CARTER, MONICA SMITH	
			ART UNIT	PAPER NUMBER
			3722	

DATE MAILED: 07/13/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/605,246

Applicant(s)

PATTON ET AL.

Examiner

Monica S. Carter

Art Unit

3722

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 May 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Request for Continued Examination

1. The request filed on May 21, 2004 for a Request for Continued Examination (RCE) under 37 CFR 1.114 based on parent Application No. 09/605,246 is acceptable and an RCE has been established. An action on the RCE follows.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over de Passillé ('573) in view of Beasley ('195).

de Passillé discloses a kit for producing an official postal product having personal image comprising a first sheet having a plurality of official postal products (11), each of the products having a first official area (area containing "CANADA" (15) and "43" (16) as seen in figure 4) having an official postal indicia and a second area (14) for receiving a personal image; a second sheet having a plurality of labels (12) each having a personal image (as seen in col. 3, lines 19-22, de Passillé disclose the definitive stamp part 11 being provided on a roll 21 that is separate from the image-bearing parts 12, thus providing first and second sheets), each of the labels being designed for placement in

the second area of the official postal product (as seen in col. 1, lines 56-61 and col. 2, lines 59-61).

de Passillé discloses the claimed invention except for the labels having a protective coating such that an official postal cancellation mark will not be permanently adhered to the personal image.

Beasley discloses a method of making personalized postage stamps comprising the steps of scanning (102) an image (104) into a storage; storing the image in a data base (110); selecting a substrate (112) for which the image is to be added; sizing the retrieved image (114); applying the image(s) to the substrate (116); evaluating the combined substrate and image product (118) and optionally applying a protective coating (120) onto the printed side of the final product (see page 3, col. 1, lines 11-25). Beasley also discloses providing different techniques for the cancellation of stamps (as seen on page 3, col. 2, lines 35-51). Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to modify de Passillé's invention to include a protective coating placed over the personal image, as taught by Beasley, to protect the life of the stamp (see page 3, col. 2, lines 24-26). Inherently, this protective coating would prevent a cancellation mark from adhering to the personal image.

Regarding the first official area being capable of retaining an official postal cancellation mark, de Passillé, as modified by Beasley, discloses providing a protective coating over the personal image as set forth above. Depending on the placement of the protective coating (e.g., not on the first official area), the first official area would be

capable of retaining an official postal cancellation mark. It has been held that the recitation that an element is "capable of" performing a function is not a positive limitation but only requires the ability to so perform. Therefore, the reference applied is required to only be "capable" of performing the claimed function.

Response to Arguments

4. Applicant's arguments filed April 26, 2004 have been fully considered but they are not persuasive.

Applicant argues that there is no motivation for modifying Passille in view of Beasley. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, both Passille and Beasley disclose postage stamps having personal images. Passille, however, fails to disclose providing a protective coating over the personal image. Beasley discloses that it is known in the art of postage products to provide a protective coating over the printed side of the final product of the stamp.

For the reasons as set forth above, the rejections are maintained.

Conclusion

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Monica S. Carter whose telephone number is (703) 305-0305. The examiner can normally be reached on Monday-Thursday (6:30 AM - 4:00 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrea L. Wellington can be reached on (703) 308-2159. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

July 9, 2004



**MONICA S. CARTER
PRIMARY EXAMINER**